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M.H.

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/242,803	02/24/99	EL KHIATI	N 3633-462

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IM52/0706

EXAMINER

SAMPLE, D

ART UNIT

PAPER NUMBER

1755

15

DATE MAILED: 07/06/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action

Application N .

09/242,803

Applicant(s)

EL KHIATI ET AL.

Examiner

David R. Sample

Art Unit

1755

--Th MAILING DATE of this communication app ars on th cover sh et with the correspond nce address --

THE REPLY FILED 15 June 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
(a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) ____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: ____.

Claim(s) objected to: ____.

Claim(s) rejected: 19, 20 and 23-32.

Claim(s) withdrawn from consideration: ____.

8. ☐ The proposed drawing correction filed on ____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). ____.
10. ☐ Other:


David R. Sample
Primary Examiner
Art Unit: 1755

Continuation of 2. NOTE: The amendment raises new issues that would require further consideration or search. Newly submitted claim 33 recites a range of $ZrO_2+Al_2O_3+SiO_2$ of 71.5 to 75. Such a range has not been previously presented and would require further consideration and/or search.

Continuation of 3. Applicant's reply has overcome the following rejection(s): the obviousness type double patenting rejection over US 5,990,023, and the § 102(e) rejection over El Khiati et al. (US Patent No. 6,063,718).

Continuation of 5. does NOT place the application in condition for allowance because:

The amendments to claims 29-32 would be entered if submitted in a separate amendment.

Applicants argue that they are entitled to their foreign priority date, and therefore, El Khiati et al. (US Patent No. 6,063,718) and Siedel et al. are not prior art. Applicants cited MPEP 715 which states:

"(D) Where the effective filing date of applicant's or patent owner's parent application or an International Convention proved filing date is prior to the effective date of the reference, an affidavit or declaration under 37 CFR 1.131 is unnecessary because the reference is not used. See MPEP § 201.11 to § 201.15." MPEP 715.

The key words in the above citations are "International Convention proved filing date". The "International Convention proved date" in the present application appears to be March 12, 1998, the filing date of the PCT application. Thus, upon further consideration, applicants are correct in asserting that El Khiati et al. is not prior art under 35 U.S.C. § 102(e).

However, obviousness-type double patenting is a separate issue and cannot be overcome by asserting an effective filing date prior to the § 102(e) date of the reference. Applicants have not overcome the obviousness-type double patenting rejection over El Khiati et al. Applicants assert in their response that a terminal disclaimer was filed over US Patent No. 6,063,718, however, none has been received.

Siedel et al. (US Patent No. 5,990,023) has a § 102(e) date of March 11, 1998, which is prior to the PCT filing date. Therefore, applicants cannot overcome the rejection by asserting that they are entitled to their International Convention date, i.e., PCT date. Applicants can overcome this rejection if they are entitled to the filing date of their foreign priority documents. To be entitled to priority, the priority documents must support the claimed subject matter under 35 U.S.C. § 112, first paragraph, including the written description requirement. See MPEP 201.15.

Applicants have submitted certified translations of their priority documents, however, applicants are not entitled to their foreign priority date. The foreign priority documents fail to provide adequate written support for at least the reason that the priority documents fail to describe a glass containing as low as 2 wt% Na_2O .

The examiner wishes to note that he has not thoroughly reviewed the priority documents to determine each instance where the documents provide adequate written support for the claimed subject matter, and where they do not. Therefore, if applicants amend their claims in attempt to be entitled to priority, they should carefully review the claims and the priority documents to be sure that the priority documents provide adequate written support for each recitation of the amended claims.

As to the rejection over Koch et al, the bulk of applicants arguments are that Koch et al. fails to disclose a glass that simultaneously contains greater than 55 wt% SiO_2 and a strain point of greater than 570 C. For the reasons already of record, this rejection is not deemed persuasive. Koch et al. clearly discloses glasses containing greater than 55 wt% SiO_2 and a strain point of greater than 570 C. See the abstract and col. 6, lines 29-30 and col. 7, lines 12-14.

Applicants argue that Koch et al. has a phi value outside the present claims. However, argument cannot take the place of evidence where evidence is necessary. See MPEP 2145 I. Such evidence, in declaration form, would be sufficient to overcome the rejection